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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/603,804 | 06/26/2003 | Do-Woo Kang | K-0532 | 2798 |
| 34610 | 7590 | 06/07/2005 | EXAMINER | |
| FLESHNER & KIM, LLP P.O. BOX 221200 CHANTILLY, VA 20153 | | | LOUIS JACQUES, JACQUES H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3661 | |

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,804

Applicant(s)

KANG ET AL.

Examiner

Jacques H Louis-Jacques

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3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-10 is/are allowed.
- 6) ☒ Claim(s) 1,5,11,12,14 and 15 is/are rejected.
- 7) ☒ Claim(s) 2-4 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Applicant has perfected the priority claim by provided a certified translation of the foreign priority document in accordance with 37 CFR 1.55. See MPEP § 201.15.

Accordingly, the patent application publication [US 2004/0193961] to Zheng et al, having an effective US filing date of February 28, 2003, is not prior art against the claims of the present application. Therefore, the rejection applying the Zheng et al reference has been withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasin et al [6,011,830].

Sasin et al discloses an operation test device and method for performing an operational test for a system under test, such as mobile telephone. The device, according to Sasin et al, comprising a test block including test commands and a test user interface for testing

the performance of the mobile station, wherein the test block and test interface being including within the mobile station (abstract), and wherein the apparatus tests the performance of the mobile station by operating the test block driven through the test user interface (figure 1a). Sasin et al also discloses a diagnostic monitoring device (figure 1b).

See also figure 21c and columns 5-6.

4. Claim 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Ghisler et al [6,118,982].

Ghisler et al discloses a method and arrangement in a mobile unit. Ghisler et al discloses a mobile terminal (mobile telephone unit (ME))) and an apparatus for testing the performance of the mobile station (mobile telephone unit) comprising: a test block including test commands or programs (abstract, column 3) and a test user interface for testing the performance of the mobile station (column 3, 12), wherein the test block and test interface being including within the mobile station (figures 1, 2). See al column 2, lines 6-35. According also to Binder et al, the apparatus tests the performance of the mobile station by operating the test block driven through the test user interface. See columns 2, 3 , 12.

5. Claim 1 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Binder et al [US 2003/0156549].

Binder et al discloses a method and system for evaluating wireless application. According to Binder et al, there is provided a mobile terminal (station) and an apparatus for testing a performance of a mobile station, such as a cellular phone or a personal digital assistant (PDA), having a global positioning system (GPS) function, comprising: a test block

including test commands and a test user interface for testing the performance of the mobile station, wherein the test block and test interface being including within the mobile station (figure 1, pages 2-3). According also to Binder et al, the apparatus tests the performance of the mobile station by operating the test block driven through the test user interface (pages 3 and 4). See also page 5.

6. Claim 1 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al [6,891,803].

Chang et al discloses a telecommunications transmission test set. Chang et al discloses a mobile terminal (station) and an apparatus for testing a performance of a mobile station, such as a cellular phone or a personal digital assistant (PDA), having a global positioning system (GPS) function, comprising: a test block including test commands and a test user interface for testing the performance of the mobile station, wherein the test block and test interface being including within the mobile station (abstract, figure 2, 3A, 4A). According also to Binder et al, the apparatus tests the performance of the mobile station by operating the test block driven through the test user interface. See columns 3 and 5-6.

7. Claim 1 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by McGregor et al [US 2004/0058652].

McGregor et al discloses a method and system for quality of service (QoS) monitoring for wireless devices. McGregor et al discloses a mobile terminal (110) and an apparatus for testing the performance of the mobile station (110) comprising: a test block including test commands or programs (figure) and a test user interface for testing the performance of the mobile station (# 850, figure 8), wherein the test block and test interface being

including within the mobile station (figure 8). See also figure 9, pages 3 and 7. According also to McGregor et al, the apparatus tests the performance of the mobile station by operating the test block driven through the test user interface. See pages 7 and 8.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 11-12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al [6,891,803] in view of Burch et al [6,826,473].

Chang et al discloses the limitations as set forth above. However, Chang et al does not particular discloses that the mobile terminal has a GPS function. However, a mobile terminal, such a personal digital assistant, having GPS functions or capabilities to determine the position of the PDA (mobile terminal) is well known in the art. Burch et al discloses a PDA with integrated navigation functions. According to Burch et al, GPS navigation data are integrated with the PDA. Accordingly, GPS function of the PDA permits for the determination of a location of the PDA. See figures 2-6. Thus, it would have been obvious to one skilled in the art at the time of the invention to be motivated to modify the test set of Chang et al by incorporating the GPS function of the PDA from the system of Burch et al because such modification, as suggested by Burch et al, would

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provide a more accurate and efficient determination of the position of the mobile terminal.

In order to avoid a lengthy office action, only one set of rejection under 35 USC 103 is provided. However, all the other references are equally applicable.

Allowable Subject Matter

10. Claims 6-10 are allowed.

11. Claims 2-4 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Remarks

12. The certified translation of the Korean application has been received and entered. Accordingly, the finality of the last office has been withdrawn.

In light of the submission of the certified translation, the Zheng et al reference is not prior art against the claims of the present application.

In light of the new ground of rejection, this office action is made non-final.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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|----------------|----------|-----------|
| 6,493,425 | Abe | Dec. 2002 |
| 6,625,448 | Stern | Sep. 2003 |
| 6,641,045 | Kuriyama | Nov. 2003 |
| US 20020022943 | Lapie | Feb. 2002 |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques H Louis-Jacques whose telephone number is 571-272-6962. The examiner can normally be reached on M-Th 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on 571-272-6956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jacques H Louis-Jacques
Primary Examiner
Art Unit 3661

/jlj

Jacques H. Louis-Jacques
JACQUES H. LOUIS-JACQUES
PRIMARY EXAMINER